

Application No. 09/890,804
Art Unit 1731
February 23, 2004
Reply to Office Action of October 22, 2003

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Claims 3, 6-9, 11-20 have been canceled. Claims 1, 2, 4, 5, and 10 have been amended. Claims 21-25 have been added. Thus, claims 1, 2, 4, 5, 10, and 21-25 are pending in the present application.

No new matter has been added by way of these amendments and new claims because each amendment and new claim is supported by the present specification. For example, the amendment to claim 1 merely incorporates the subject matter of claim 3, and is supported at page 2, lines 28-33 of the present specification. With this amendment to claim 1, claims 4 and 5 were appropriately amended. Also, the amendments to claims 2, 4, 5 and 10 are obviously editorial in nature and not narrowing in scope. Thus, Applicants reserve the right to pursue any equivalent feature of the claims. New claims 21-25 have support throughout the present specification, including pages 4-11 and the various Figures (*i.e.*, see Figure 2 for new claim 24). Thus, no new matter has been added.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Application No. 09/890,804

Art Unit 1731

February 23, 2004

Reply to Office Action of October 22, 2003

Issues Under 35 U.S.C. § 112, First Paragraph

Claims 1-5 and 10 stand rejected under 35 U.S.C. § 112, first paragraph, for asserted lack of written description (as stated in paragraph 3 of the Office Action). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

The Office Action states that an article of any shape is "rollable". However, Applicants respectfully submit that such a definition is contrary to the ordinary meaning of this term, and Applicants have not defined "rollable" to be anything other than the ordinary meaning. Still, Applicants respectfully refer the Examiner to the scope of the presented claims, wherein the disputed claim language is no longer present. Thus, this rejection is rendered moot. Reconsideration and withdrawal of this rejection are respectfully requested.

Issues Under 35 U.S.C. § 102(e)

Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Cooper et al. '669 (U.S. Patent No. 6,352,669) (as stated in paragraphs 4-5 of the Office Action). Applicants respectfully traverse.

Applicants respectfully refer the Examiner to instantly pending claim 1, which incorporates the subject matter of claim 3. Because the

Application No. 09/890,804

Art Unit 1731

February 23, 2004

Reply to Office Action of October 22, 2003

subject matter of claim 3 is not at issue here, Applicants respectfully submit that claim 1 and all dependent claims thereon are instantly allowable.

Further, Applicants respectfully submit that the cited Cooper '669 fails to disclose all features as instantly claimed. Instead, Cooper '669 merely discloses a support structure that supports green parts during sintering to maintain the shape (see the Abstract; see Col. 2, starting at line 58). There is no disclosure in Cooper '669 of the present invention, especially considering that the green support structures of the Cooper '669 reference are not inert vis-à-vis the firing process as instantly claimed. Thus, because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited Cooper '669 reference cannot be a basis for a rejection under § 102(e). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Cooper '669 is overcome. Reconsideration and withdrawal are respectfully requested.

Applicants also question if Cooper '669 is really prior to the present invention. It is not clear that the provisional application (Appl. No. 60/105,265) fully supports the disclosure of the issued patent, and thus prior to Applicants' priority date.

Application No. 09/890,804
Art Unit 1731
February 23, 2004
Reply to Office Action of October 22, 2003

Issues Under 35 U.S.C. § 103(a)

Claims 1 and 2 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper '669 (as stated in paragraphs 6-8 of the Office Action). This rejection respectfully is traversed to the extent deemed to apply to the claims as amended.

Again, Applicants respectfully refer the Examiner to instantly pending claim 1, which incorporates the subject matter of claim 3. Claim 2 depends on claim 1. Because the subject matter of claim 3 is not at issue here, Applicants respectfully submit that claim 1 and all dependent claims thereon (*i.e.*, claim 2) are instantly allowable.

Applicants further respectfully submit that a *prima facie* case of obviousness has not been formed with respect to the asserted modification of Cooper '669 because not all requirements for a *prima facie* case of obviousness have been satisfied. For instance, not even the initial requirement of disclosure of all claimed features has been satisfied. See *In re Vaeck*, 947 F.2d, 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Here, the cited Cooper '669 reference does not disclose or recognize the present invention's achievement of, for example, the firing material resting on movable supporting materials which can be composed of any material which is inert vis-à-vis the firing process. Thus, Applicants respectfully submit that not all requirements for a *prima facie* case of obviousness have been satisfied and that this rejection under 35 U.S.C. § 103(a) has been overcome.

Application No. 09/890,804

Art Unit 1731

February 23, 2004

Reply to Office Action of October 22, 2003

Reconsideration and withdrawal of this rejection are respectfully requested.

Applicants also submit that the requisite motivation and reasonable expectation of success are also lacking. There is no disclosure or recognition in Cooper '669 so that one of ordinary skill in this art would modify this reference to achieve the formulations as instantly claimed. Any such modification can only be accomplished by substantial and improper hindsight reconstruction.

Thus, Applicants respectfully submit that a *prima facie* case of obviousness has not been formed, and request reconsideration and withdrawal of this rejection.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 09/890,804
Art Unit 1731
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Pursuant to 37 C.F.R. § 1.17 and 1.136(a), Applicants respectfully petition for a one (1) month extension of time for filing a response in connection with the present application. The required fee of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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